

Amendment and Response

Serial No.: 09/937,076

Confirmation No.: 4527

Filed: March 27, 2002

For: METHODS OF USE OF B1-INTEGRIN INHIBITORS**Remarks**

The Office Action mailed August 10, 2004 has been received and reviewed. Claims 1, 7, 13, 21, 25, 28, 32, 35, and 38 having been amended and claim 41 having been added, the pending claims are claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, 35, 38, and 41. Claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, and 35 being withdrawn from examination, as drawn to non-elected inventions, the claim currently under examination is claim 38. Support for the amended and new claim is found throughout the specification. Reconsideration and withdrawal of the rejections are respectfully requested.

Response to Restriction Requirement

Applicants continue to traverse the Restriction Requirement mailed June 15, 2004. The instant application is a national stage application submitted under 35 U.S.C. 371. Thus, Applicants submit they have a right to have examined in a single application "those inventions which are so linked as to form a single general inventive concept" (M.P.E.P. § 1893.03(d)). "A group of inventions is considered linked to form a general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical feature is defined as meaning those technical features that define the contributions which each claimed invention, considered as a whole, makes over the prior art" (M.P.E.P. § 1893.03(d)). Applicants submit that the composition of claim 38 is novel and involves an inventive step. Applicants submit that the methods of claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, and 35, as methods of using the composition of claim 38, share a special technical feature with claim 38. The Examiner is directed to M.P.E.P. § 1850 ("Illustrations of Particular Situations-Combinations of Different Categories of Claims," page 1800-97), which states that an independent claim for a given product and an independent claim for a use of said product are to be considered as having unity of invention. Thus, Applicants request the rejoinder and examination of claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, and 35.

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Further, Applicants are puzzled by the Examiner's refusal on page 2 of the Office Action mailed August 10, 2004 to reconsider a rejoinder of product claims (claim 38) and process claims (claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, and 35) as set forth in "Guidance on Treatment of Product and Process Claims in Light of *In re Ochia*, *In re Brouwer* and 35 U.S.C. § 103(b)" (see 1184 O.G. 86 (March 26, 1996)). Such a refusal is a direct contradiction of the Examiner's statements in the Restriction Requirement mailed June 15, 2004. In the Restriction Requirement, the Examiner stated:

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all of the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance.

Office Action mailed June 15, 2005, page 4 (emphasis in original). Thus, Applicants respectfully request rejoinder of claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, 35, and 38.

Notice to Comply with 37 CFR 1.821-1.825

In accordance with 37 C.F.R. §1.821, a computer readable form (CRF) and written Sequence Listing for the instant application are submitted herewith. Applicants request that the application be amended to enter the Sequence Listing submitted herewith. In accordance with 37 C.F.R. §1.821, it is respectfully submitted that the information recorded in CRF is identical to the written sequence listing. The sequence listing does not contain new matter.

The 35 U.S.C. §112, First Paragraph, Rejection

The Examiner rejected claim 38 under 35 U.S.C. §112, first paragraph. Applicants respectfully submit that, in view of the amendment of claim 38 to recite "consisting of," this rejection under 35 U.S.C. §112, first paragraph, is moot.

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The 35 U.S.C. §102 Rejection

The Examiner rejected claim 38 under 35 U.S.C. §102(a) as being anticipated by WO 99/37669. Applicants respectfully submit that, in view of the amendment of claim 38 to recite "consisting of," this rejection under 35 U.S.C. §102(a) is moot.

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It is respectfully submitted that the pending claims 1, 4-10, 13, 17-21, 25, 28, 31, 32, 35, 38, and 41 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

CERTIFICATE UNDER 37 CFR §1.10:

"Express Mail" mailing label number:

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The undersigned hereby certifies that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Sandy TruehartName: Sandy TruehartNovember 8, 2004

Date

NAJ/SJT

Respectfully submitted for
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